



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

705191-2001

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/821,763

Filed

April 9, 2004

First Named Inventor

Rober WINSKOWICZ et al.

Art Unit

3711

Examiner

Raeann Trimiew

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).


Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 51,147

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature  
Erin M. Dunston  
Typed or printed name

202-373-6000

Telephone number

December 3, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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		Art Unit 3711	Examiner Raeann Trimiew
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<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.      51,147 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p> 32,344 Signature Erin M. Dunston Typed or printed name 202-373-6000 Telephone number December 3, 2007 Date</p>	
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<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	<b>MAIL STOP AF</b>
Robert WINSKOWICZ <i>et al.</i>	)	Group Art Unit: 3711
Application No.: 10/821,763	)	Examiner: Raeann TRIMIEW
Filed: April 9, 2004	)	Confirmation No.: 1461
For: GOLF BALL WITH WATER	)	<b>MAIL STOP AF</b>
IMMERSION INDICATOR	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicants hereby request a pre-appeal brief review pursuant to the program announced on June 20, 2005, as reported in the Official Gazette on July 12, 2005.

**Status**

Claims 1-31 are pending in this application. *Final Office Action mailed July 2, 2007, Office Action Summary, Item 4.* Claim 31 is allowed. *Id. at Item 5.* Claims 1-11, 13, 14, 16, 17, 25, and 29 stand rejected. *Id. at Item 6.* Claims 1-11, 13, 14, 16, 17, 25, and 29 have been rejected twice. *See Final Office Action mailed July 2, 2007, Office Action Summary, Item 4; see also Advisory Action mailed November 29, 2007, Item 7.*

**The Examiner's Rejection**

Claims 1-11, 13, 14, 16, 17, 25, and 29 stand finally rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,358,160 ("the '160 patent"). *Final Office Action mailed July 2, 2007, Page 2, First Paragraph.* According to the Examiner, the '160 patent "discloses a golf ball comprising a surface with indicia and a gloss coating (masking layer) over the surface. Once the coating is penetrated the indicia will appear on the surface (fig 9). The indicia indicates the ball has been exposed to water and has changed characteristics. With respect to claims 2-5, the coating layer obviously includes all the limitations when exposed to water. The coating layer also included a water activated binder since it is capable of being penetrated by water." *Id.* Applicants

respectfully submit that the Examiner's rejection of Claims 1-11, 13, 14, 16, 17, 25, and 29 results from clear error.<sup>1</sup> Applicants maintain that there is a fundamental difference between Applicants' claimed invention and that of the '160 patent.

### **Anticipation and Obviousness**

"Invalidity based on 'anticipation' requires that the invention is not in fact new." *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002) (quoting *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995)). "A single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art." *Verve*, 311 F.3d at 1120 (citing *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). Put differently, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness is decided after considering the scope and content of the prior art, the differences between the claimed invention and the prior art, and after resolving the level of skill in the art. See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. at \_\_\_, 82 U.S.P.Q.2d 1385, 1391 (2007). An Examiner's obviousness analysis should be explicit. *KSR*, 550 U.S. at \_\_\_, 82 U.S.P.Q.2d at 1396; see also 72(195) Fed. R. 57526-35 at 57527-29 (Oct. 10, 2007).

### **The Examiner's Rejection Results From Clear Error**

Applicants respectfully submit that Claims 1-11, 13, 14, 16, 17, 25, and 29 are neither anticipated nor obvious because the '160 patent fails to disclose each and every element of those claims. For example, Claim 1 (from which Claims 2-11, 13, 14, 16, 17, 25, and 29 depend) is a method claim. Claim 1 is a method for providing a golf ball with a visual indication that at least one property of the golf ball has been altered due to the presence of water, comprising applying a water-activated mask that is altered to permit viewing of a covered indicator upon being

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<sup>1</sup> Applicants believe the Examiner's anticipation and obviousness rejections are conclusory at least because they fail to explain the Examiner's *reasons* for the rejections. The lack of detail in the rejections is exemplified by the most recent Advisory Action that states simply "the arguments are not persuasive." *Advisory Action mailed November 29, 2007, Item 11.*

subjected to water. The method of Claim 1 requires applying a water-activated mask. Once the mask is activated with water, the indicator over which the mask was applied becomes viewable. The mask may be referred to as an "opacification layer." As Page 5, Lines 2-5 of the Specification state, "Under normal conditions the opacification layer blocks the view of the underlying surface. When the opacification layer is water-activated it becomes transparent or is removed, thus unmasking the underlying layer." Page 5, Lines 7-9 of the Specification further state, "Depending on the type of physical operation involved, immersion of the golf ball for a sufficiently long period of time causes the opacification layer to either be rendered transparent, to be removed, or to reduce its light-blocking characteristics."

The '160 patent does not anticipate nor render obvious Claims 1-11, 13, 14, 16, 17, 25, and 29 because the '160 patent is silent with regard to Applicants' claimed water-activated unmasking of an indicator. The invention of the '160 patent is summarized at Column 1, Line 59 through Column 2, Line 9 of the '160 patent.

The instant application reiterates the attributes of the '160 patent when it states: "Note that U.S. Patent 6,658,160 utilizes water-activated ink which either appears or disappears upon the immersion of the golf ball in water." *Page 3, Lines 18-19 of the Specification*. Applicants' instant application distinguishes the claimed invention from that of the '160 patent by explaining that "a golf ball with indicia or a particular recognizable color is overlain with an opacification layer that provides a mask over the indicia or the colored ball . . . The opacification layer when removed or otherwise made transparent, while providing for a change in the appearance of the golf ball upon water immersion, does not need to have a layer or indicia which changes color in reaction to the infusion of water." *Page 8, Lines 4-11 of the Specification* (emphasis added).

That the Examiner has twice rejected Claims 1-11, 13, 14, 16, 17, 25, and 29 evidences a fundamental misunderstanding between Applicants and the Examiner with regard to their invention as it pertains to the '160 patent. The method of Claim 1 requires applying a water-activated mask to a golf ball that *already contains* an indicator. When the golf ball is subjected

to water, the mask is activated such that it is altered so as to permit viewing of the underlying, already existing indicator.

The method of Claim 1 employs a golf ball that contains an indicator that is already in its final indicator state. The indicator is not initially visible, as it is hidden by a mask. If, however, the golf ball is exposed to water, the mask is activated. Upon activation, the mask is altered to permit viewing of the indicator. The important point is that the indicator does not change. Instead, only the mask, upon being activated by water, changes.

The golf balls claimed in the '160 patent are different from the golf balls employed in Applicants' claimed methods because the golf balls claimed in the '160 patent have imprints upon them made with a water-activated ink and those imprints change when exposed to water.

The golf balls claimed in the '160 patent are different from the golf balls employed in Applicants' claimed methods because the golf balls in the '160 patent have imprints upon them made with a water-activated ink. Because those imprints are made with water-activated ink, they need not be hidden from view and thus require no masking layer. Should another layer be coated over those imprints the coating need not be opaque and, in fact, may be transparent or clear. Because the imprints are made using water-activated ink, the ink changes upon exposure to water and thus the imprints themselves change in the golf balls in the '160 patent. This stands in stark contrast to the golf balls employed in Applicants' claimed methods whose indicator is already in its final indicator state and does not change upon exposure to water.

Applicants submit that when this fundamental difference between Applicants' claimed invention and the invention of the '160 patent is appreciated, it becomes apparent that the '160 patent neither anticipates nor renders obvious Applicants claimed methods.

Applicants take this opportunity to address the relationship between the '160 patent and the instant application. The claims of the '160 patent are broad, in that they use open-ended "comprising" language. In that regard, the claims of the '160 patent could be said to dominate Claims 1-31 in the instant application. A useful discussion of this is set forth in *In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986), which was submitted in the record earlier:

By domination we refer, in accordance with established patent law terminology, to that phenomenon, which grows out of the fact that patents have claims, whereunder one patent has broad or "generic" claims which "reads on" an invention defined by a narrower or more specific claim in another patent, the former "dominating" the latter because the more narrowly claimed invention cannot be practiced without infringing the broader claim. To use the words of which the board seemed to be enamored, the broader claim "embraces" or "emcompasses" the subject matter defined by the narrower claim. In possibly simpler terms, one patent dominates another if a claim of the first patent reads on a device built or process practiced according to the second patent disclosure.

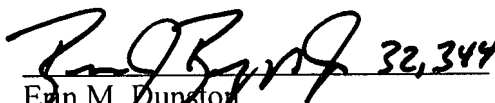
*In re Kaplan*, 789 F.2d at 1577. While the claims of the '160 patent may dominate Claims 1-31 of the instant application, the claims of the '160 patent neither anticipate nor render obvious Claims 1-31, at least because the '160 patent is silent with regard to Applicants' water-activated mask that is altered to permit viewing of a covered indicator upon being subjected to water.

The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4047.

Respectfully submitted,  
BINGHAM MCCUTCHEN, LLP

Date: December 3, 2007

By:

  
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